## II. Remarks

Reconsideration and re-examination of this application in view of the following remarks is herein respectfully requested.

Claims 2 and 21 have been cancelled. Claims 1, 3-20, and 22 remain pending.

*Claim Rejections - 35 U.S.C. §103*

Claims 1, and 4-7 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,695,813 to Boyle (Boyle) in view of U.S. Patent No. 5,681,347 to Cathcart, et al. (Cathcart) in view of U.S. Patent No. 5,484,444 to Braunschweiler et al. (Braunschweiler).

In addressing the rejections, applicants feel that a more detailed discussion of the prior art may be useful when reviewing the instant claims. The claims refer to a medical grasping device. As mentioned in the background section, such devices may be used to retrieve or position catheters, wires, stents, or even retrieving calcified deposits such as kidney stones. As such, the grasping portion may deliver torque and/or longitudinal forces to the grasped item to manipulate that item. The independent claims denote that the elongate control member is a cannula and as such the grasping portion is attached to the cannula. The references cited by the examiner to not teach or suggest this relationship.

Boyle teaches a conical filter assembly. The conical filter assembly expands and allows blood to flow through openings in a conical assembly. Debris that is larger than the openings are forced to the center of the cone due to the flow of blood. While, the cone can be collapsed for removal, applicants contend that the pressure

from the blood flow maintains the position of the debris with respect to the conical structure and that the filter would generally not be considered a grasping device. In addition, the filter in Boyle is free to spin about the on the guidewire and no elongate control member (cannula) is provided that attaches to the filter. Therefore, even if the examiners contention is correct that the filter is a grasping portion, still the elements that define the relationship of the grasping portion to the cannula, sheath, and guidewire are not provided. The filter is not attached to an elongate control member, rather, the filter merely spins about the guidewire.

Cathcart is a deployment device for a vena cava filter. A lever is used to advance a rod that pushes the vena cava filter from a catheter into the vessel. The vena cava filter is independent from the rod and catheter, and the vena cava filter remains at the delivery site, while the deployment device is removed. Cathcart does not teach a grasping portion and, therefore cannot teach the relationship between the grasping portion and the elongate control member provided in the claims.

Braunschweiler is a stent delivery device. Again no grasping portion is provided. The stent is housed in between a rod and a sheath. The sheath retracts allowing the stent to expand against the walls of the vessel. However, the stent is not a grasping device and although the stent may engage the rod it is not attached to the rod. Once the stent is fully deployed the delivery device is removed while the stent remains in the vessel. Therefore, Braunschweiler cannot teach the relationship between the grasping device and elongate control member provided in the claims.

The examiner bears the burden of establishing the *prima facia* case of obviousness, and "[f]or the teachings of a reference to be prior art under Section 103, there must be some basis for concluding that the reference would have been considered by one skilled in the particular art working on the pertinent problem to

which the invention pertains." *In re Horn,* 203, USPQ 969, 971. Applicants contend that the combination when taken as a whole does not teach each of the elements claimed. "The examiner must step backward in time and into the shoes worn by the hypothetical `person of ordinary skill in the art' when the invention was unknown and just before it was made." MPEP §2142. In the instant rejection, the examiner has combined up to five references, of devices that function quite differently. Rather, the Examiner has picked distinct features from unrelated references using hindsight to reconstruct the instant claims. Applicants, respectfully submit that such reconstruction is improper.

However, even combining the references according to the examiner's arguments, every element of the claims are not taught. In general, the cited references are not grasping devices. More specifically, the grasping portion and the relationship of the grasping portion being attached to the elongate control member for urging the grasping portion in and out of the sheath are not shown by the references.

The examiners analysis contends that Boyle shows the grasping portion (filter) distal an atrumatic tip and the sheath. However, Boyle does not teach an elongate control member only the wireguide and that the filter spins freely around the wireguide. Boyle does not teach a grasping portion attached to an elongate control member (cannula) in operative relation to the control assembly for urging the grasping portion in and out of the sheath.

The examiner contends that Cathcart shows the control assembly and that it would be obvious to use the control assembly of Cathcart to deploy the filter in Boyle. But these devices are fundamentally different. The device in Cathcart is independent from the rod and releases from the assembly to stay in the vessel. The

filter in Boyle is attached to the wireguide and is designed to rotate freely about the wireguide. Still neither device teaches a grasping portion attached to an elongate control member (cannula) for urging the grasping portion in and out of the sheath.

Further, the examiner contends that Braunschweiler teaches a cannula and a sheath used in connection with a guide wire. Braunschweiler teaches a stent, not grasping portion. Further, while the stent may engage the cannula it is independent from and not attached to the cannula. Therefore, the relationship of the grasping portion being attached to the elongate control member (cannula) has still not been addressed.

Claims 4-7 depend from claim 1 and are, therefore, patentable for at least the same reasons as given above in support of claim 1.

Additionally with respect to claim 4, the examiner does not address that the outer sheath has lubricious outer and inner surfaces.

Claim 3 was rejected under 35 U.S.C. §103(a) as being unpatentable over Boyle in view of Cathcart, in view of Braunschweiler, in view of U.S. Patent No. 5,330,484 to Günther et al. (Günther).

Günther does not teach the elements noted above as missing from Boyle, Cathcart, and Braunschweiler. Further, claim 3 depends from claim 1 and is, therefore, patentable for at least the same reasons as given above in support of claim 1.

Claims 8-22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Boyle in view of Cathcart, and in view of U.S. Patent No. 5,098,440 to Hillstead (Hillstead) in view of Braunschweiler.

Hillstead does not teach the elements noted above as missing from Boyle, Cathcart, and Braunschweiler. Similar to claim 1, claim 22 defines that the elongate control member is a cannula and that the grasping portion is attached to the cannula.

Additionally, with respect to claim 22, the examiner does not address that the outer sheath has lubricious outer and inner surfaces. Further, the references do not disclose the wire loops having proximal end portions that are joined to an elongate control member (cannula) at affixation joints or that the wire loops are made of a nitinol.

Claims 8-20 depend from claim 1 and are, therefore, patentable for at least the same reasons as given above in support of claim 1.

In addition, there are elements of some dependent claims that the examiner summarily dismisses. Some of these additional elements are provided below.

With respect to claim 12, the examiner does not address that the arcuate outer section of the loops have a radius about equal to a radius of the deployment site. Clearly as shown in Figure 12 of Hillstead the arcuate outer sections of the loops have a radius that is significantly smaller that the vessel.

With respect to claim 13, the examiner does not address that four preformed wire loops are used and that the wire loops occupy the full cross-section of the vessel. Clearly as shown in Figure 12 when the loops of Hillstead are deployed they are very oblong and the areas to the side of the loops 126 and 128 are open and therefore items adjacent to the loops can not be grasped. This problem is not contemplated in Hillstead because the device was designed to retrieve stents which generally occupy the full cross section of the vessel.

With respect to claim 14, Hillstead does not mention that the wire loops are made of a super elastic alloy.

With respect to claim 15, the examiner does not address the wire loops having proximal end portions that are joined to an elongate control member at affixation joints. As discussed earlier Boyle does not teach an elongate control member and further, Hillstead does not teach an elongate control member. Much less the proximal ends of the loops being attached by affixation joints.

With respect to claim 17, as discussed above with respect to claim 15, the references do not disclose the wire loops having proximal end portions that are joined to an elongate control member at affixation joints.

With respect to claims 18 and 19, Hillstead does not mention that the wire loops are made of a nitinol.

With respect to claim 20, as discussed above with respect to claim 4, the examiner does not address that the outer sheath has lubricious outer and inner surfaces. Further, as discussed above with respect to claim 15, the references do not disclose the wire loops having proximal end portions that are joined to an elongate control member at affixation joints.

*Conclusion*

In view of the above amendments and remarks, it is respectfully submitted that the present form of the claims are patentably distinguishable over the art of record and that this application is now in condition for allowance. Such action is respectfully requested.

Respectfully submitted by,

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